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EXAMINER

HERRING, VIRGIL A

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Appeal 2009-006277
Application 10/090,426

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAURI PAATERO

Appeal 2009-006277
Application 10/090,426
Technology Center 2400

Before ELENI MANTIS MERCADER, CARL W. WHITEHEAD, JR., and
BRADLEY W. BAUMEISTER, *Administrative Patent Judges*.

WHITEHEAD, JR., *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-27, 35-43, 45 and 47-50. App. Br. 2. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We affirm.

Claim 1, which further illustrates the invention, follows:

1. A method, comprising:

embedding a role certificate in a device, wherein the role certificate identifies at least one permitted activity that at least one party is allowed to perform with respect to the device, and wherein the role certificate is generated by a certification authority;

embedding at least information regarding a public key in said device, the public key corresponding to the private key used by the certification authority to sign the role certificate; and

running the device so as to verify the role certificate using said information regarding the certification authority public key so that said at least one permitted activity can be activated within the device by said at least one party if the role certificate is verified,

wherein the at least one party communicates with the device to perform the permitted activity, only after the role certificate is embedded in said device,

wherein the at least one party performs the at least one permitted activity by establishing a wireless connection to the device, and

wherein the role certificate also identifies the at least one party.

The Rejection

Claims 1-27, 35-43 and 47-50 stand rejected under 35 U.S.C. § 102(e), as being unpatentable over Doyle (U.S. Patent 6,968,453 B2; November 22, 2005). *See* Ans. 5-9.

Rather than repeat Appellant's arguments or the Examiner's positions in their entirety, we refer to the Appeal Brief (filed October 22, 2007), Reply Brief (filed May 9, 2008) and the Answer (mailed January 9, 2008) for their respective details. In this decision, we have considered only those arguments actually made by Appellant. Arguments which Appellant could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008).

ISSUE

Does the Doyle reference properly incorporate the Hind reference for the purposes of anticipating the Appellant's independent claims?

FINDINGS OF FACTS

1. Column 11, lines 18-40 of Doyle discloses:

Furthermore, the referenced inventions describe selective enablement of functionality that is pre-stored in a device. For example, as discussed therein, a manufacturer might choose to ship a single code base that is capable of providing multiple levels of device functionality, and based on what the consumer pays for, a particular level of this pre-stored functionality will be made available by modifying the firmware on the consumer's device. This selective enablement approach may also be used advantageously with the components of the present invention whereby an attached component may initially be

configured for (and authenticated for) providing one set of functionality, and then this initial functionality may subsequently be revised or upgraded 30 (using the teachings of the related inventions) to allow access to other functionality. According to the present invention, the revised or upgraded functionality may either be presumed authentic by the already-established authentication of the component in which it resides, provided that 35 component remains attached to the security core. (Alternatively, an implementation of the present invention may be configured such that this type of firmware revision requires an additional authentication process for the attached component.)

PRINCIPLES OF LAW

A § 102 rejection based on the subject matter of an incorporated-by-reference document can be sustained only if the primary reference that incorporates-by-reference the document refers to a particular part of the incorporated-by-reference document. *In re Saunders*, 444 F.2d 599, 602 (CCPA 1971).

[A]n incorporation by reference must be set forth in the specification and must:

- (1) Express a clear intent to incorporate by reference by using the root words “incorporate(e)” and “reference” (e.g., “incorporate by reference”); and
- (2) Clearly identify the referenced patent, application, or publication.

37 C.F.R. § 1.57(b).

“To incorporate material by reference, the host document must identify with *detailed particularity* what specific material it incorporates and *clearly indicate where* that material is found in the various documents.” *Zenon*

Environmental, Inc. v. United States Filter Corp., 506 F.3d 1370, 1378 (Fed. Cir. 2007), *reh'g en banc denied* Feb. 12, 2008 (internal citations omitted).

ANALYSIS

Appellant argues the Doyle reference relied upon by the Examiner improperly incorporated the Hind reference (Application number 09/614,983 now US Patent 6,976,163 B1) for purposes of anticipating the limitations of the independent claims because Doyle never directs attention to any specific portions of Hind that are relied upon by the Examiner to reject claim 46 in the Final Office Action². *See* Appeal Brief 5; *see also* Reply Brief 2-3. The Examiner asserts that Hind is properly incorporated and relies upon 37 C.F.R. §1.57 for support. *See* Answer 10-11.

The Examiner relied upon line 18, column 11 of Doyle for “enablement of functionality that is pre-stored in a device” to reject claim 46. *See* Final Rejection 16; *see also* FF1. The Appellant argues that it is the Examiner’s reliance upon line 18 of Doyle that is not sufficient for purposes of anticipating the limitations of the independent claims because Doyle fails to indentify and provide the location for the Hind material being incorporated. *See* Appeal Brief 5. However, in the Answer, the Examiner did not limit his reliance upon Doyle to just line 18 but expanded his reliance to lines 18-40 to address the newly amended independent claims

² Claim 46 was filed by Appellant on February 15, 2006 and was originally dependent upon claim 1. In an Advisory Action mailed June 29, 2007, the Examiner indicated that Appellant’s Amendment After Final, received June 11, 2007, would be entered for purposes of an appeal. In the Amendment After Final, the Appellant incorporated the limitation of claim 46 into the independent claims. *See* After Final Amendment 2-9, 11.

that included the limitations of claim 46. *See* Answer 5-9. It is in column 11, lines 20-40, that Doyle provides a detailed example of the selective enablement of the functionality that is pre-stored in a device that was cited in line 18. *See* FF 1.

A § 102 rejection based on the subject matter of an incorporated-by-reference document can be sustained only if the primary reference that incorporates-by-reference the document refers to a particular part of the incorporated-by-reference document. *In re Saunders*, 444 F.2d 599, 602 (CCPA 1971). We find that Doyle does incorporate-by-reference the Hind teaching regarding the selective enablement of the functionality that is pre-stored in a device with particularity by explicitly describing the incorporated subject matter (*see* col. 11, ll. 18-40) and by identifying the referenced patent applications (*see* col. 8, ll. 1-15).

Appellant contends that “clearly identifying where [the incorporated] material is found in the various documents” in accordance with *Zenon Environmental* requires that the incorporated material be referenced with more specificity than merely pointing to the entire document that is being incorporated (e.g., the material must be referenced with a pinpoint citation). App. Br. 5. We are not persuaded by Appellant’s argument.

The decision of *Zenon Environmental* does not require pinpoint citations in order for the incorporation to be effective. In *Zenon Environmental*, the application at bar contained the following incorporation by reference language:

The vertical skein is not the subject matter of this invention and any prior art vertical skein may be used. Further *details relating to the construction and deployment of a most preferred skein* are found in the parent U.S. Pat. No. 5,639,373, and in Ser. No. 08/690,045, *the relevant disclosures of each of*

which are included by reference thereto as if fully set forth herein.

Zenon Environmental Inc., 506 F.3d at 1379. The court did not find any deficiencies attributable to the fact that the incorporation language failed to include pinpoint cites. Rather, the court merely found that the incorporation was ineffective with respect to the parent patent's gas distribution system because the parent patent disclosed that the skein and gas-distribution system were separate. *Id.* at 1379-82.

Furthermore, in reaching its decision, the *Zenon Environmental* court noted that the following incorporation language had been previously found to be sufficient to incorporate a method for preparing a tissue graft composition from a segment of the small intestine: "The preparation of UBS from a segment of urinary bladder is similar to the procedure for preparing intestinal submucosa detailed in U.S. Patent No. 4,902,508 ["the 508 patent"], the disclosure of which is expressly incorporated herein by reference." *Id.* at 1381 (internal citation omitted). The fact that this language contains no pinpoint citation further evidences that disclosing a particular patent document *in its entirety* can be sufficient to "clearly indicate[] where that material is found in the various documents" as required by *Zenon Environmental*.

Appellant additionally argues that the Manual for Patent Examining Procedure (M.P.E.P.) also requires that Doyle's incorporation by reference statement identify the specific portions of Hind that are being incorporated. Reply Br. 3. Specifically, Appellant cites to M.P.E.P. § 608.01(p)(I)(A), which states: "Particular attention *should be* directed to specific portions of the referenced document where the subject matter being incorporated may

be found” (emphasis added). This argument is not persuasive either. The M.P.E.P. is not binding authority. Furthermore, regardless of what deference is to be afforded the M.P.E.P., the use of the words “should be” in M.P.E.P. § 608.01(p)(I)(A) indicates that this provision is merely laudatory – not mandatory.

Accordingly, we will affirm the Examiner’s rejection of claim 1 and, for similar reasons as those articulated *supra*, the rejections of claims 2-27, 35-43 and 47-50.

DECISION

We affirm the Examiner’s 35 U.S.C. § 102(e) rejection of claims 1-27, 35-43, 45 and 47-50 as anticipated Doyle.

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

ORDER

AFFIRMED

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